

**REMARKS**

Upon entry of this Amendment, claims 1-60 and 62-74 are all the claims pending in the application. Claim 61 has been cancelled. Claims 30-57 and 62-74 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 1-29 and 58-61 presently stand rejected. Specifically, claims 1-29 and 58-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 29 of US Patent No. 6,181,463. Additionally, claim 61 is objected to under 37 C.F.R. §1.75 as being a substantial duplicate of claim 59.

For the reasons set forth below, Applicants respectfully traverse the rejection of claims 1-29 and 58-61 and request favorable disposition of the application.

***§ 1.75 Objection***

Claim 61 is objected to under 37 C.F.R. § 1.75. In response, Applicant has canceled claim 61.

***Double Patenting Rejection***

Claims 1-29 and 58-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 29<sup>1</sup> of U.S. Patent No. 6,181,463

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<sup>1</sup> In the second full paragraph of page 3 of the office action the Examiner asserts that claims 1-29 and 58-61 are obvious variants of **claim 1** of the '463 patent. However, in the third full paragraph, it is **claim 29** of the '463 patent that is asserted. Since no justification whatsoever was provided for the  
...(footnote continued)

("463"). In response, Applicant submits that for several reasons a *prima facie* case of one-way obviousness has not been established between claim 29 of the '463 patent and any of claims 1-29 and 58-61 of the present application.

As the Examiner is no doubt aware, an obviousness-type double patenting rejection rests on the prohibition against issuance of a second patent that would continue protection of a mere obvious variant of a first patented invention beyond the first patent's expiration date.<sup>2</sup> The Federal Circuit Court, in *In re Kaplan*, held that obviousness-type double patenting rejections must include clear evidence to establish why an alleged variation of an invention claimed in a prior patent would have been obvious.<sup>3</sup>

Here, the Examiner has not attempted to provide *any* evidence, let alone *clear evidence*, to establish why the invention claimed in claims 1-29 and 58-61 of the present application is an obvious variant of that which is claimed in claim 29 of the '463 patent. In fact, the Examiner merely asserts that the claims of the present application are "more specific embodiments of the device shown in '463 claim 29" and thus, they "are covered by this device." However, such an assertion, even if true, does not establish a *prima facie* case of obviousness-type double patenting. The *Kaplan* court explicitly denounced the assertion that an invention defined by

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rejection as it applies to claim 1, Applicant assumes that claim 29 was the intended claim for the double patenting rejection.

<sup>2</sup> See *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986).

<sup>3</sup> *Id.*, 229 USPQ at 683.

subsequent specific claims that can be read-on by broader predecessor claims is a *per se* obvious variant of the predecessor claims.<sup>4</sup>

Applicant respectfully submits that to establish a *prima facie* case of obviousness-type double patenting, the Examiner must first identify the inventions claimed in each of claims 1-29 and 58-61 of the present application as well as the invention claimed in claim 29 of the '463 patent. The Examiner must then establish that any variation between the inventions claimed in the present claims and claim 29 of the '463 patent would have been obvious to a person of ordinary skill in the art. Furthermore, the analysis involved in establishing obviousness with respect to obviousness-type double patenting must be the same analysis as that which is performed to establish a *prima facie* case of obviousness under 35 U.S.C. §103.<sup>5</sup> None of these requirements has been met by the Examiner in this case.

For the reasons stated above, Applicant submits that a *prima facie* case of obviousness-type double patenting has not been established. For this reason and, further, because Applicant submits that none of claims 1-29 and 58-61 are obvious variants of claim 29 of the '463 patent, Applicant respectfully requests that the double patenting rejection of claims 1-29 and 58-60 be withdrawn.

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<sup>4</sup> *Id.* at 681.

<sup>5</sup> *See In re Longi*, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985).

Additionally, however, Applicant provides the discussion below to demonstrate the clear differences between that which is claimed in claim 29 of US Patent No. 6,181,463 and that which is claimed in claims 1-29 and 58-61 of the present application.

One need only cursorily review the recited elements within the respective claims to recognize the fundamental differences between the present claims and claim 29 of US Patent No. 6,181,463. Claim 29 of US Patent No. 6,181,463 is directed to a parametric amplifier. Both a pump source and a signal source are recited that are temporally overlapped with substantially the same pulse width. A quasi-phase-matched crystal receives these signals and creates the amplification. In the present claims, however, a fiber amplifier is clearly recited. In a fiber amplifier, as recited in the present claims, a doped rare-earth material such as erbium or ytterbium ions are excited by a pump source and the ion transition is then in an excited state. There is a population inversion that creates gain.

Accordingly, the two types of lasers are fundamentally different, and claims to one type could in no way overlap with the other.

### ***Conclusion***

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-29 and 58-60, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 09/576,772

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